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OFFICE OF PETITIONS

In re Application of
Zhang, Lawrence, Lima, Miller & Hall
Application No.: 10/616,319
Filed: July 9, 2003
Attorney Docket No.: 133860-2
(MHM 14882US02)
For: ULTRASOUND BREAST SCREENING
DEVICE

DECISION REFUSING STATUS
UNDER 37 CFR 1.47(a)

This is a decision on the petition under 37 CFR 1.47(a), filed November 17, 2003.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)" and must include an oath or declaration executed by the inventors. **Failure to respond will result in abandonment of the application.**

The above-identified application was filed on July 9, 2003 without an executed oath or declaration. Accordingly, on October 6, 2003, a "Notice to File Missing Parts of Nonprovisional Application" was mailed, requiring an executed oath or declaration and a surcharge for its late filing.

In response, on November 17, 2003 a declaration executed by 3 of 5 joint inventors, the surcharge, the petition fee, and the instant petition were filed. A declaration of facts of Attorney Joseph M. Butscher, accompanied the petition. Attorney Butscher explains that non-signing joint inventors Lawrence and Lima were each Express Mailed a copy of the entire application and a declaration, but each did not respond to the request that he sign the declaration for the patent application within a reasonable specified period of time.

A grantable petition under 37 CFR 1.47(a) requires

- (1) a petition including proof of the pertinent facts establishing that the joint inventor(s) refuses to join, or cannot be found or reached after diligent effort,
- (2) a proper oath or Declaration executed by the available joint inventor(s),
- (3) the fee of \$130 as specified in 37 CFR § 1.17(h), and
- (4) the last known address of the omitted inventor(s).

This petition lacks item (2) above.

As to item (2), an oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.64 still has not been presented. There are three problems with the declaration.

1. The declaration contains an noninitialed, nondated alteration to Inventor Zhang's citizenship. 37 CFR 1.52(c) states that "[a]ny interlineation, erasure, cancellation or other alteration of the application papers filed should be made on or before the signing of the accompanying oath or declaration pursuant to 1.63...." This includes the oath or declaration. The Office will not consider whether noninitialed and or nondated alterations were made before or after signing of the oath or declaration but will require a new oath or declaration. See MPEP 605.04(a).

2. The format of the declaration is not acceptable. The first page of the Declaration does not list all joint inventors and the Declaration does not include page numbers -- i.e. 1 of 2; 2 of 2. As such, there could be ambiguity with respect to how many inventors there are. The Declaration should set forth all of the joint inventors on the same page to ensure that each named inventor is aware of the other named inventors of the subject matter. See 37 CFR 1.63.

3. Because petitioners know their application number, it should be referenced on the first page of the declaration after the application's filing date.

An oath or declaration in compliance with 37 CFR 1.63 and 1.64 signed by the Rule 1.47 applicants on behalf of Messrs. Lawrence and Lima is REQUIRED. See MPEP 409.03(a).


Further correspondence with respect to this matter should be addressed as follows:

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